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S/N: 10/673,865

REMARKS

Claims 1-20 are pending in the present application. In the Office Action mailed August 27, 2004, the Examiner rejected claims 1-10 and 16-20 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant appreciates the indication that claims 11-15 are allowed.

The Examiner rejected claims 1-10 and 16-20 under 35 U.S.C. §112, second paragraph, for "failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention". The Examiner then suggested some language modifications that were deemed required. Applicant appreciates the Examiner's suggestions; however, Applicant does not believe claims 1-10 and 16-20 to lack definiteness.

Claim 1 calls for "(A) determining an average diffusion value in at least one voxel; (B) determining a respective diffusion value for one or more diffusion directions in the at least one voxel; and (C) from the respective diffusion values and the average diffusion value, determining a diffusion index indicative of diffusion in the at least one voxel." It is well-established practice before the Office to use "the" before a noun if the noun has already appeared in the claim chain. Step A of claim 1 includes a reference to "at least one voxel" thus it is clear that the "the at least one voxel" referenced in step B relates to the "at least one voxel" of step A. One skilled in the art would readily recognize that "the at least one voxel" referenced in step B relates back to the "at least one voxel" of step A without inclusion of "step A" at the end of step B as suggested by the Examiner.

This same analysis can be applied to the other suggestions made by the Examiner with respect to claim 1. That is, Applicant believes one skilled in the art would readily appreciate what Applicant regards as the invention without inclusion of "of step B" and "of step A" in steps B and C, respectively, as suggested by the Examiner.

Regarding the Examiner's requirement that "respective" be replaced with "corresponding", Applicant respectfully disagrees and reminds the Examiner that "examiners are encouraged to suggest the claim language to applicants to improve the clarity or precision of language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement." MPEP §2173.02. That is, "when the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness." MPEP §2173.02. In this regard, the Examiner is to afford "some latitude in the manner of expression and the aptness of terms should be permitted even though the claim

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language is not as precise as the Examiner might desire." MPEP §2173.02. The Examiner is reminded that "the essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularly." MPEP §2173.02. As such, Applicant does not believe a change is necessary as one skilled in the art would readily ascertain that called for in claim 1 as it is currently written.

The Examiner has also required an amendment to claim 16 to clarify what is meant by "at least one voxel". Applicant does not believe such an amendment is required. Lines 4-5 of claim 16 calls for "at least one voxel". One skilled in the art would readily appreciate that "at least one voxel" may include a single voxel or multiple voxels. Lines 6 and 8, in further defining the invention, recite "the at least one voxel". Applying conventional claim construction principles it is clear that "the at least one voxel" in lines 6 and 8 refers back to the "at least one voxel" of lines 4-5. As such, it is clear that whatever voxel or voxels are referenced in lines 4-5, that/those same voxel/voxels are referenced in lines 6 and 8. Accordingly, Applicant believes that the amendment suggested by the Examiner is not needed as one skilled in the art would readily ascertain what Applicant regards as the invention called for in claim 16. As the Examiner has provided no other basis of rejection for claims 1-10 and 16-20, Applicant believes these claims to be in condition for allowance.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-20.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,


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